

REMARKS

A) For the sake of clarity, the file history is summarized hereby:

- 1) On July 25, 1996, applicant filed a provisional application which was assigned the serial No. 08/687,315. That application was subject to a restriction/election (to/of one group of claims). The group of claims chosen by the applicant was allowed and granted in US Patent No. 5,855,312 on January 5, 1999.
- 2) On July 17, 1997 (i.e. during the "twelve months" period of the previous one), applicant filed international application No. PCT/IB97/00887 designating the United States of America. Said PCT/IB97/00887 claimed the priority of the original application 08/687,315 (comprising the whole set of claims as originally filed).
- 3) A copy of the international application was communicated to the USPTO from the International Bureau on February 05, 1998.
- 4) A demand for International Preliminary Examination was timely filed with the USPTO on February 09, 1998. Accordingly, the "thirty months" period for paying the basic national fee for the national stage in the US expired at midnight on January 25, 1999.
- 5) On December 28, 1998 (i.e. within said thirty months period and while application 08/687,315 was still pending), a first divisional application was filed and was assigned the No. 09/214,039. That application 09/214,039 was (here again) subject to a "restriction to and election of one group of claims" requirement. Further, the same application (09/214,039) was subject to a Continued Prosecution Application (CPA) during the pendency of 09/214,039.
- 6) The CPA of 09/214,039 filed on May 2001 was made because "the amendments proposed in 09/214,039 raised new issues requiring further consideration and/or search". That CPA, which was in essence a duplicate of 09/214,039 was (surprisingly) assigned a new application number – 09/846,362 – by the USPTO Officer, while concomitantly abandoning the previous one (09/214,039). Nevertheless, the document corresponding to both serial numbers 09/214,039 and 09/846,362 was granted in US Patent 6,338,737 on January 15, 2002. The front page of that Patent 6,338,737 shows the cross reference between the application numbers 09/214,039 and 09/846,362.
- 7) On November 26, 2001 - i.e. during the pendency of the previous document (09/214,039 or its CPA 09/846,362) - applicant filed a second divisional application for protecting the remaining claims that were not elected in the previous "restriction/election requirement". Said second divisional application was assigned the serial No. 10/009,038 in two filing receipts of the USPTO - the second filing receipt was made after the first one had been vacated in compliance with the decision of the (US) PCT legal office from March 16, 2004.
- 8) The substance of application 10/009,038 has been examined thoroughly for many years by the first USPTO Examiner and now -nearly eight years after the filing of the demand for a patent was made- it is all of a sudden and unexpectedly being examined as to its legal form by present Examiner in last Office Action. Needless to say that this wouldn't leave much time to benefit from the fruit of an eventual patent which would derive from application 10/009,038 (less than eight years at best!).

B) The following is structured so as to answer each corresponding item in the Examiner's Office Action dating June 12, 2008.

Allowable Subject Matter

Claims 67-72, allowed in previous Examiner's communications, have been withdrawn from allowance in last Examiner's communication. The ground for the present rejection is based on an "anticipation" of these claims by other applications [US applic. Numbers 08/687315 and 09/214039] to the present applicant. The Examiner is respectfully informed that said "other applications" are in fact the original and parent applications of the present one.

It is reminded that:

- i) present application is a divisional application of the former ones filed as a result of a USPTO requirement for restriction.
- ii) present divisional application is directed to subject matter described and claimed in the original and parent applications (US applic. Numbers 08/687315 and 09/214039), before the restriction and election was requested.
- iii) present application has been filed before the issuance of the patent of its parent application (US applic. 09/846362 which is a CPA of 09/214039). [The copendency between present application and its former one was hence respected].

Said original and parent applications cannot therefore (pursuant to 35 U.S.C. 121), "be used as a reference either in the Patent Trademark Office or in the courts against (the) divisional application or against the original application or any patent issued on either of them".

Priority

Applicant has claimed the benefit of prior-filed applications in a preliminary amendment to present application. The information concerning the benefit claim was recognized by the USPTO as shown by its inclusion on the filing receipt. No petition and no surcharge are hence required.

In compliance with 37 CFR 1.78(a), applicant is hereabove submitting the reference to the prior applications by filling an amendment to the first sentence of the specification. Said reference to the prior applications is a summary of the file history described hereabove. Further, it is emphasized, that the chain of pendencies all along the different applications of this file has never been interrupted. The benefit of the prior-filed original application (i.e US ser. N.08/687315) is hence deemed to be in order. Consecutively, the Examiner is respectfully requested:

- 1) to cancel the withdrawal from allowability of claims 67-72. The "newly discovered reference(s) to Toledano", raised by the Examiner, is a parent application of the current one and cannot –in the above described context- be considered as an anticipating document. ("Toledano" happens to be the present applicant himself and the sole inventor of the two applications that have been already issued, namely 08/687315 and 09/846362 or 09/214,039 which are in fact the same).
- 2) to set aside –in current application- every rejection made on the basis of any anticipation by application numbers 08/687315 and 09/214039 (or 09/846362).

Claim Rejections – 35 USC § 112

Claim 58 was rejected under this item for its grammatical error in line 12. The correction of that error is submitted herewith and the claim is hence deemed to be in order.

Claim Rejections – 35 USC § 102

Claims 56-76 were rejected under this item as being anticipated by Toledano (US 5,855,312). That later application –as discussed hereabove under the item "priority"- is a parent prior application to the current one and cannot therefore be used against its "daughter" - the present

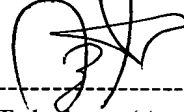
application - for matter of 35 USC § 102(b). These claims are hence, deemed to be in order.

Further and respectfully, in his development of the rejections of said claims 56-76, the Examiner has inadvertently referred the matter of claim 75 to Figure 16 while that claim does not refer to that Figure at all. Indeed, claim 75 is a claim depending on claim 56. Claim 56, as widely discussed in applicant's previous letter (dating June 05, 2007) to USPTO, describes a multitude of surgical situations such as in Figures 11, 12 and 14 (but not 16). Please reconsult chapter "FACTS" in applicant's response dating June 05, 2007.

Further, the applicant –for matter of a better protection of claim 67- has added a new claim 77 to the list of pending claims. The new claim 77 is depending on independent claim 67. Support for the amendment made can be found in the specification on page 30, line 18 – page 31, line 12; on page 9, line 20 – page 10, line 15 and in Figure 16.

In view of the discussion and corrections hereabove it is respectfully considered that this application is now in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully Submitted



Haviv Toledano (Applicant/Inventor)

Date: September 01, 2008